

REMARKS

The Office Action of December 10, 2008, has been reviewed and these remarks are responsive thereto. Claims 20-22 were canceled previously. Claims 54-55 have been added in the present paper. No new matter has been added. Claims 1-19 and 23-55 are pending upon entry of the present paper. Reconsideration and allowance of the instant application are respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-5 and 30-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. pat. no. 5,600,573 to Hendricks et al. ("Hendricks"), in view of U.S. pat. no. 5,956,716 to Kenner et al. ("Kenner"), U.S. pat. no. 5,855,020 to Kirsch ("Kirsch"), U.S. pat. no. 5,806,061 to Chaudhuri et al. ("Chaudhuri"), and U.S. pub. no. 2001/0039546 to Moore et al. ("Moore"). Claims 6-10, 14-19, and 23-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks, Kenner, Kirsch, Chaudhuri, and Moore, and further in view of U.S. pub. no. 2002/0038308 to Cappi ("Cappi"). Claims 11-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks, Kenner, Kirsch, Chaudhuri, Moore, and Cappi, and further in view of U.S. pat. no. 6,772,150 to Whitman et al. ("Whitman") and U.S. pat. no. 6,839,705 to Grooters ("Grooters"). Claims 33, 39-44, 46, 47, 50, 51, and 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kenner in view of Kirsch, Chaudhuri, and Moore. Claims 34-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kenner, Kirsch, Chaudhuri, and Moore, and further in view of Whitman. Claims 37 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kenner, Kirsch, Chaudhuri, Moore, and Whitman, and further in view of U.S. pat. no. 6,243,713 to Nelson et al. ("Nelson"). Claims 45 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kenner, Kirsch, Chaudhuri, and Moore, and further in view of Grooters. Claims 49 and 52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kenner, Kirsch, Chaudhuri, and Moore, and further in view of Nelson. These rejections are traversed below.

Independent claim 1 recites, “a content search suggestion engine, wherein said content search suggestion engine suggests content based on a user’s past search criteria or previously downloaded content.”

The Office Action at page 8 correctly indicates that Hendricks, Kenner, Kirsch, and Chaudhuri fail to disclose the above-noted features recited in claim 1. The Office Action at page 8 contends that Moore at paragraph [0035] discloses the recited features. Applicants respectfully disagree.

At pages 16-17 of Applicants’ “Response Under 37 C.F.R. 1.116” filed October 8, 2008, Applicants distinguished the above-noted features over Moore. Applicants incorporate those remarks herein by way of reference. In short, Moore at paragraph [0035] describes using a user’s current search to suggest content. Conversely, the above-noted features recited in claim 1 relate to suggesting content based on a user’s past search criteria or previously downloaded content. Thus, notwithstanding whether any combination of the applied references is proper, the combination fails to result in at least the above-noted features recited in claim 1. As such, claim 1 is allowable for at least these reasons.

The Office Action at page 2 (“Response to Arguments”) states that Applicants remarks have been considered, contending that Applicants’ prior remarks were rendered moot in view of the new grounds of rejection; yet, the Office continues to rely primarily on Moore to allegedly demonstrate the above-noted features recited in claim 1. In the event that the Office maintains a rejection of claim 1 based on Moore, pursuant to MPEP § 707.07(f), Applicants respectfully request the Office to answer the substance of Applicants’ remarks with respect to Moore.

Moreover, claim 1 recites, “an aggregator, wherein said aggregator implements a screening process in response to a user request for limiting a number of programs retrieved to those programs with a viewing audience above a predetermined threshold . . . that rejects specific items . . .”

The Office Action at pages 6-7 correctly indicates that Hendricks, Kenner, and Kirsch fail to disclose the above-noted features related to a screening process that limits a number of programs retrieved to those programs with a viewing audience above a

predetermined threshold. The Office Action at page 7 appears to rely on Chaudhuri to cure the deficiencies of Hendricks, Kenner, and Kirsch, but notably the Office Action does not contend that Chaudhuri describes a screening process that limits a number of programs retrieved to those programs with a viewing audience above a predetermined threshold. Indeed, Chaudhuri is wholly silent with respect to a screening process limiting a number of programs retrieved to those programs with a viewing audience above a predetermined threshold. Thus, notwithstanding whether a combination of Hendricks, Kenner, Kirsch, and Chaudhuri is proper, the combination fails to teach or suggest such features. Furthermore, Moore fails to describe these features as well. As such, claim 1 is allowable for at least these additional reasons.

Independent claims 33 and 50 recite features similar to those described above with respect to claim 1. As such, claims 33 and 50 are allowable for at least reasons similar to those described above with respect to claim 1.

The dependent claims are allowable for at least the same reasons as their respective base claims because any of the additional references of record (e.g., Cappi, Whitman, Grooters, and Nelson) fail to cure the deficiencies of Hendricks, Kenner, Kirsch, Chaudhuri, and Moore described above. The dependent claims are further allowable in view of the features recited therein.

For example, claim 25 recites, among other features, “a current hardware configuration, wherein the current hardware configuration is provided to a coder and content formatter that formats the search request form for delivery to a user terminal.” The Office Action at pages 19-20 correctly indicates that Hendricks, Kenner, Kirsch, Chaudhuri, Moore, and Cappi fail to describe at least the above-noted features. The Office Action contends that such features were notoriously well known to a person of ordinary skill in the art. Applicants respectfully request the Office to provide proof/documentation that such features were well-known at the time of the instant invention in order to avoid impermissible hindsight due to the passage of time. Pending such proof/documentation, Applicants submit that claim 25 is further allowable in view of these features.

New Claim(s)

Claims 54 and 55 have been added in the present paper. While the referenced claims have not been subjected to examination to date, Applicants offer the following remarks in an effort to expedite the prosecution.

Independent claim 54 is directed to an apparatus comprising a processor and memory storing instructions that when executed by the processor, cause the apparatus to perform features similar to those recited in independent (method) claim 33. As such, claim 54 is allowable for at least reasons similar to those described above with respect to claim 33. Illustrative, non-limiting written description support for the processor and memory is provided in the filed specification when read as a whole, and for example, at page 10, line 27 – page 11, line 6 and page 14, line 29 – page 15, line 8.

Claim 55 depends from claim 54 and is allowable for at least the same reasons as claim 54.

CONCLUSION

If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account 19-0733 in the appropriate amount.

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Date: April 10, 2009

By: /Mark E. Wilinski/
Mark E. Wilinski, Registration No. 63,230

1100 13th Street, N.W.
Suite 1200
Washington, D.C. 20005-4051
Tel: (202) 824-3000
Fax: (202) 824-3001